

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EL635468400US  
Express Mail Label Number

June 27, 2002  
Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

SONNTAG ET AL.

APPLICATION NO: 10/048,134

FILED: JANUARY 23, 2002

FOR: EPOTHILONE COMPOSITIONS

**Attention: Box PCT**

Assistant Commissioner for Patents  
Washington, DC 20231

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC 371

Sir:

The NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC 371 dated March 27, 2002 (a copy of which is enclosed) has a shortened statutory time set to expire on May 27, 2002.

A one-month extension is hereby requested pursuant to 37 CFR §1.136(a). Please charge Deposit Account No. 19-0134 in the name of Novartis Corporation in the amount of \$110 for payment of the extension fee. However, reconsideration of this fee is requested below.

The NOTIFICATION indicates that this application is missing (1) the oath or declaration of the inventors, and (2) a computer readable copy of the sequence listing. Applicants assert that the declaration of the inventors has been submitted and that no computer readable copy of a sequence listing is required.

Applicants records indicate that an executed declaration of the inventors was submitted with the Transmittal Letter dated January 23, 2002. Thus, there should be no need to submit another declaration. A copy of the previously submitted declaration is attached.

The present application contains no sequence listings. Therefore, no sequence listing or computer readable form thereof is required.

Applicants submit that the NOTIFICATION was sent in error and the none of the allegedly missing items is missing. Therefore, Applicants request for all fees associated with this response to be waived.

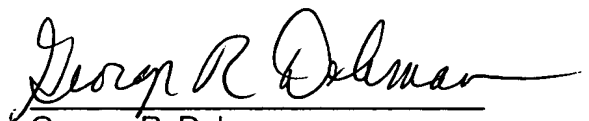
The Commissioner is hereby authorized to charge any additional fees under 37 CFR §1.17 which may be required, or credit any overpayment, to Account No. 19-0134 in the name of Novartis Corporation.

A duplicate copy of this letter is provided for charging purposes.

Novartis Corporation  
Patent and Trademark Dept.  
564 Morris Avenue  
Summit, NJ 07901-1027

Date: June 27, 2002

Respectfully submitted,



George R. Dohmann  
Attorney for Applicants  
Reg. No. 33,593  
(908) 522-6922

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**FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10**

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Form PTO-1390-MOD (REV 10-96)		U. S. Department of Commerce Patent and Trademark Office	ATTORNEY'S DOCKET NUMBER 4-31102A
<b>TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371</b>			U.S. APPLICATION NO. (If known, see 37 CFR 1.5) 10/048,134
INTERNATIONAL APPLICATION NO.	INTERNATIONAL FILING DATE	PRIORITY DATE CLAIMED 8 April 1999 (08.04.99)	
TITLE OF INVENTION EPOTHILONE COMPOSITIONS			
APPLICANT(S) FOR DO/EO/US SONNTAG ET AL.			

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☐ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☒ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☐ This express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1).
4. ☐ A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5. ☐ A copy of the International Application as filed (35 U.S.C. 371(c)(2))
  - a. ☐ is transmitted herewith (required only if not transmitted by the International Bureau).
  - b. ☐ has been transmitted by the International Bureau.
  - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☐ A translation of the International Application into English (35 U.S.C. 371(c)(2)).
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)).
  - a. ☐ are transmitted herewith (required only if not transmitted by the International Bureau).
  - b. ☐ have been transmitted by the International Bureau.
  - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
  - d. ☐ have not been made and will not be made.
8. ☐ A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☒ An executed Declaration and Power of Attorney (original or copy) (35 U.S.C. 371(c)(4)).
10. ☐ A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Items 11. to 16. below concern document(s) or information included.

11. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☐ A FIRST preliminary amendment.  
☐ A SECOND or SUBSEQUENT preliminary amendment.
14. ☐ A substitute specification.
15. ☐ A change of power of attorney and/or address letter.
16. ☒ Other items or information: Response to Notification of Missing Requirements Under 35 USC 371 (2 pages); copy of postcard stamped 1/23/2002 from PCT/PTO

U.S. APPLICATION NO. (if known, see 37 CFR 1.5)  
10/048,134

INTERNATIONAL APPLICATION NO.

ATTORNEY'S DOCKET NUMBER  
4-31102A

17. ☒ The following fees are submitted:

**BASIC NATIONAL FEE (37 CFR 1.492(a) (1)-(5)):**

Search Report has been prepared by the EPO or JPO .....	\$840
International preliminary examination fee paid to USPTO (37 CFR 1.482) .....	\$670
No international preliminary examination fee paid to USPTO (37 CFR 1.482) but international search fee paid to USPTO (37 CFR 1.445(a)(2)) .....	\$760
Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO .....	\$970
International preliminary examination fee paid to USPTO (37 CFR 1.482) and all claims satisfied provisions of PCT Article 33(2)-(4) .....	\$96

**CALCULATIONS PTO USE ONLY**

**ENTER APPROPRIATE BASIC FEE AMOUNT =**

\$  
\$ 130

Surcharge of \$130 for furnishing the oath of declaration later than ☐ 20 ☒ 30 months from the earliest claimed priority date (37 CFR 1.492(e)).

CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE
Total claims	0	- 20 =	0
Independent claims	0	- 3 =	0
MULTIPLE DEPENDENT CLAIM(S) (if applicable)			+ \$ 260

**TOTAL OF ABOVE CALCULATIONS =**

\$ 130

Reduction of 1/2 for filing by small entity, if applicable. Verified Small Entity Statement must also be filed (Note 37 CFR 1.9, 1.27, 1.28).

**SUBTOTAL =**

\$ 130

Processing fee of \$130 for furnishing the English translation later than ☐ 20 ☐ 30 months from the earliest claimed priority date (37 CFR 1.492(f)).

**TOTAL NATIONAL FEE =**

\$ 130

Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40 per property.

**TOTAL FEES ENCLOSED =**

\$ 130


Amount to be:  
refunded \$  
charged \$

- a. ☐ A check in the amount of \$\_\_\_\_\_ to cover the above fees is enclosed.
- b. ☒ Please charge Deposit Account No. 19-0134 in the name of Novartis Corporation in the amount of \$130 to cover the above fees. Two duplicate copies of this form are enclosed.
- c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 19-0134 in the name of Novartis Corporation.

**NOTE:** Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status.

Send all correspondence to the address associated with Customer No. 001095, which is currently:

Thomas Hoxie  
Novartis Corporation  
Patent and Trademark Dept.  
564 Morris Avenue  
Summit, NJ 07901-1027

  
George R. Dohmann  
Attorney for Applicants  
Reg. No. 33,593  
(908) 522-6922



UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box PCT  
 United States Patent and Trademark Office  
 Washington, D.C. 20231  
 www.uspto.gov

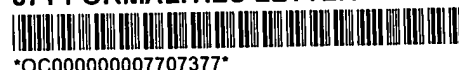
U.S. APPLICATION NUMBER NO. 10/048,134	FIRST NAMED APPLICANT Sonntag	ATTY. DOCKET NO. 4-31102A
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 001095  
 THOMAS HOXIE  
 NOVARTIS CORPORATION  
 PATENT AND TRADEMARK DEPT  
 564 MORRIS AVENUE  
 SUMMIT, NJ 079011027

GRD



INTERNATIONAL APPLICATION NO. PCT/EP00/07488	
I.A. FILING DATE 08/02/2000	PRIORITY DATE 08/04/1999

 CONFIRMATION NO. 2734  
 371 FORMALITIES LETTER


\*OC000000007707377\*

Date Mailed: 03/27/2002

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Priority Document
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Preliminary Amendments

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- \$130 Surcharge for providing the oath or declaration later than the appropriate 30 months months from the priority date (37 CFR 1.492(e)) is required.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

**SEQUENCE LISTING REQUIRED**

 DOCKETED FOR: May 27 2002

The following items **MUST** be furnished within the period set forth below:

- The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):
  - A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
  - A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
  - **APPLICANT MUST PROVIDE:**
    - An initial or substitute computer readable form (CRF) of the "Sequence Listing."
    - An initial or substitute paper copy or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.
    - A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).
- For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:
  - For Rules Interpretation, call (703) 308-4216
  - To Purchase PatentIn Software, call (703) 306-2600
  - For PatentIn Software Program Help, call (703) 306-4119 or e-mail at [patin21help@uspto.gov](mailto:patin21help@uspto.gov) or [patin3help@uspto.gov](mailto:patin3help@uspto.gov)

#### SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$130** for a Large Entity:

- **\$130** Late oath or declaration Surcharge.
- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
- A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

BARBARA A CAMPBELL

Telephone: (703) 305-3631

#### PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/048,134	PCT/EP00/07488	4-31102A

FORM PCT/DO/EO/905 (371 Formalities Notice)

Case No. 4-31102A

Application No. 10/048134

Mailing Date: 7/23/2002

Due Date: 2/4/2002

Express Mail No.: EL91301398US ✓

The Patent & Trademark Office acknowledges, and has stamped hereon the date of receipt of the items checked below:

☐ Amendment/Response/Letter - Fee \$

☒ Appln. Filing Papers - Fee \$ 890.00

☒ PCT National Stage

☐ Provisional Application

☐ CPA ☐ DIV ☐ CONT ☐ CIP

☐ Specification Pg's

☒ Executed/Unexecuted Decl. - Fee \$ 0-

☐ Missing Parts/Missing Req.

☒ Preliminary Amendment

☐ Claim of Priority ☐ Certified Copy(s)

☐ Amendment After Final

☐ Notice of Appeal - Fee \$

☐ Appeal Brief - Fee \$

☐ Issue Fee Payment \$

☐ Assignment Rec. Req. - Fee \$

☐ Formal Drawings Pg's

☐ IDS Pg's - Fee \$

☐ PTO-1449 Form

☐ Pet. for Ext. of Time - Fee \$

☐ Pet. to Convert to Prov. Appln. - Fee \$

☐ Seq. Listings Pg's/Seq. Disk

☒ Application Data Sheet

GRD

Initials

JC18 Rec'd PCT/PTO 23 JAN 2002

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